



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,177	08/29/2000	Robert A. Cordery	F-190	9743

919 7590 06/03/2003

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/650,177
Filing Date: August 29, 2000
Appellant(s): CORDERY ET AL.

MAILED

JUN 03 2003

GROUP 3600

Brian A. Lemm, Reg. No. 43,748
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 April 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3621

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 35 and 36 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,005,200	FISCHER	4-1991
5,715,314	PAYNE et al.	2-1998

(10) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following ground(s) of rejection are applicable to the appealed claims:

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher, U.S. Patent No. 5,005,200 in view of Payne et al., U.S. Patent No. 5,715,314.

As per claims 35 and 36, Fisher teaches a method for obtaining a cryptographic certificate comprising: sending a certificate request to a certificate authority, receiving the certificate from the authority, including a public key of a public/private key pair and activating the private key (column 3, lines 53-68; column 6, lines 36-65; column 18, lines 32-68). However, Fisher does not explicitly recite a register having funds stored, determining if sufficient funds are present, and deducting funds from the register for obtaining a certificate. Payne teaches a network sales system comprising a register having funds stored therein that allows a transaction between buyer and merchant to take place if the user account has sufficient funds or credit (figures 1, 2G; column 7, lines 5-30). Therefore, it would have been obvious to combine the systems of Fisher and Payne et al.. By having an independent payment computer (e.g. a bank) verify a

Art Unit: 3621

user's ability to pay prior to completing a transaction a merchant, such as a certificate authority, can guarantee compensation for services rendered.

(11) *Response to Argument*

In general, Appellant's arguments take an overly narrow view of the claim language, and grossly underestimate the level of knowledge of those of ordinary skill. The Appellant in their argument consistently refers to a "meter", and relies on this characterization of the Appellant's claimed system to differentiate it from the combined the prior art of Fischer and Payne et al.. Specifically the Appellant recites,

Thus the certificate meter of the present invention is a secure device with secret information that allows secure communication with a certificate authority such as a post office or other trusted third party and the capability to use, manage and execute various security services. The certificate meter of the present invention includes metering and accounting capability that allows convenient low cost payment of charges per use of a certificate (Appeal Brief, page 6, lines 8-12)

Fischer, in contrast, is directed to a public key cryptographic system with enhanced digital signature certification that authenticates the identity of the public key holder (Appeal Brief, page 6, lines 13-14)

... As noted above, the payment system of Payne et al. is a conventional credit card payment system, and not a meter having funds stored therein... (Appeal Brief, page 9, lines 24-27)

... the Final Rejection has not provided any motivation for providing a secure user certification system for electronic commerce that provides an accounting system for services provided as in the present invention (Appeal Brief, page/line 9/29-10/1)

However, this assessment of the claimed invention as a meter or as a secure user certification system (Appeal Brief, page 9, lines 9/29-10/1) is clearly false. On the contrary claim 35 is written as follows,

A method for obtaining a cryptographic certificate, comprising the steps of:

- providing a register having funds stored therein;
- determining if sufficient funds are present in the register for obtaining the certificate;
- sending a certificate request to a certificate authority;
- receiving the cryptographic certificate from the certificate authority; and
- deducting funds from the register for obtaining the requested certificate.

No meter. Therefore, the only difference between the *claimed* invention and the combined prior art is a register having funds stored therein, determining if funds are present and deducting funds from the register for obtaining a certificate (Appeal Brief, page 6, lines 23-27). However, this is clearly taught by Payne et al. ('314, figure 1, figure 2G, items 76, 80, 88 and 92, figure 2H, items 94 and 98, and figure 2I items 101, 102 and 104; column 7, lines 5-30). The Appellant attempts to disparage the teachings of Payne by stating there is no register having funds stored therein (Appeal Brief, page 8, lines 8-15), choosing to ignore the clear teachings of the prior art ("payment computer verifies whether user account has sufficient funds or credit" figure 2G and column 7, lines 14-17). But what is a register? Webster's Ninth New Collegiate Dictionary (page 992) defines a "register" as an "automatic device registering a number or quantity" and a "device (as in a computer) for storing small amounts of data; esp: one in which data can be both stored and operated on". Hence to one of ordinary skill the computer or device that stores the user account is and meets the definition of a "register". And, although not

Art Unit: 3621

explicitly recited, the presence of a such a computer or device that stores user accounts is at least obvious (a reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art (*In re Delisle*, 160USPQ 806 (CCPA 1969))), as it, the account, is accessible by the payment computer ('314, figures 1 and 2G). The Payne et al. reference teaches a method and system that can be used to securely obtain a product ('314, abstract). Fischer provides such a product, a certificate from a certificate authority ('200, column 3, lines 53-68; column 6, lines 36-65; column 18, lines 32-68). The Examiner would also like to point out that what is being obtained, i.e. the certificate, is non-functional data, as it is not functionally related to the substrate of the article of manufacture (*In re Gullack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Regarding claim 36, the Appellant has once again attempted to differentiate the Appellant's system from the combined prior art by relying on features not recited in the claims. Specifically, the Appellant asserts that the prior art does not teach or suggest,

generating a first cryptographic key pair, and deducting funds from the register for obtaining the requested certificate which activates a first private key of the first cryptographic key pair (Appeal Brief, page 13, lines 4-7)

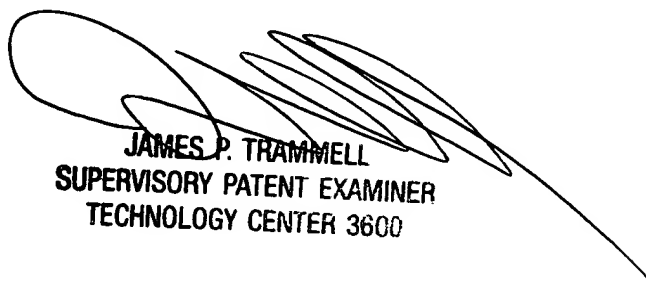
However, claim 36 fails to link the activation of the private key and the deducting of funds. Note claim 36 also fails to recite a deducting step. On the other hand, the prior art of Fischer clearly reads on claim 36 as written as Fischer teaches generating the

Art Unit: 3621

certificate that includes a public key of a public/private key pair and activating the first private key ('200, column 3, lines 53-68; column 6, lines 36-65; column 18, lines 32-68).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Calvin Loyd Hewitt II
May 28, 2003

Conferees
James P. Trammell 

Melanie Kemper

Brian A. Lemm
Pitney Bowes Inc.
Intellectual Property and Technology Law Department
35 Waterview Drive
Shelton, CT 06484-8000